

## REMARKS

### Claims 1-20

Claims 1-20 have been rejected under 35 USC 103(a) as being unpatentable over Freitag et al. (US6785102), in view of Pinarbasi (US2003/0179515).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 1-3, 8, 10-12, 15 and 18 (as amended) prior to the effective 35 USC 102(a) date of Freitag (December 11, 2003). Per MPEP 715.02, Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, applicant respectfully requests that the Examiner withdraw the rejection of claims 1-3, 8, 10-12, 15 and 18 based on Freitag. Further, applicant respectfully requests that the Examiner withdraw the rejection of the remaining claims based their dependence on such claims.

Assuming arguendo that the Examiner wishes to pursue a rejection under 35 USC 103(a)/102(e) based on Freitag, such a reference would be overcome under the provisions of 35 USC 103(c).

Freitag was published on December 11, 2003, after the date of invention shown in the attached declaration under 37 CFR 1.131 (September 8, 2003). Therefore, the rejection of claims 1-3, 8, 10-12, 15 and 18 under 35 USC 103 would be based on 35 USC 102(e) art. Applicant believes that Freitag is disqualified as prior art to the present invention under 35 USC 103(c). Please find attached a statement signed by an attorney of record that Freitag and the present application were both owned by and/or subject to an obligation of assignment to Hitachi Global Storage Technologies Netherlands B.V. at the time of invention of the subject matter of the claimed invention in the present application.

Applicant believes that the statement is sufficient to overcome any evidentiary requirement of the Examiner, particularly in light of the following quotes from MPEP 706.02(l)(2)(II):

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

...

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

“Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.”

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

Applicant believes that the disqualification of Freitag renders claims 1-3, 8, 10-12, 15, and 18 allowable over the references cited in the rejection. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

With respect to claims 5 and 14, the Examiner has relied on Figure 10 from Freitag in attempt to make a prior art showing of applicant's free layer having a

thickness of less than about 30Å, where Freitag's free layer as illustrated is 30Å (see item 202 of Fig. 10 in Freitag). Applicant has amended such claims to require that "the free layer has a thickness of less than 30Å" (emphasis added). Thus, such rejection is deemed avoided in view of applicant's amendment. Accordingly, a notice of allowance is respectfully requested.

With respect to claims 4 and 13, applicant has also amended such claims to include that "the free layer has a thickness of less than 30Å." Thus, applicant respectfully asserts that such claims are also allowable over Freitag for the same reasons set forth with respect to claims 5 and 14.

With respect to claim 6, the Examiner has relied on Figure 10 from Freitag in attempt to make a prior art showing of applicant's claimed technique "wherein the free layer has a thickness of between about 15 and 25Å." Freitag's free layer is clearly illustrated as 30Å (see item 202 of Fig. 10 in Freitag), 20% more than applicant's top range of 25Å, as claimed. Thus, such rejection is improper. Accordingly, a notice of allowance is respectfully requested.

With respect to claims 7 and 16, the Examiner has relied on Figure 10 from Freitag in attempt to make a prior art showing of applicant's claimed technique "wherein a half voltage of the head is more than two times greater than a half voltage of a head having a substantially similar structure but having only one barrier layer." Specifically, the Examiner has implied that such limitation is inherent in Freitag.

However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Rather, to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applying these rules to the present application, the lack of any indication of how the claimed features not literally disclosed in Freitag are inherently present, besides the Examiner’s recitation of Ohm’s law, renders the rejection of claims 7 and 16 inappropriate. Clearly, stating  $V=IR$  as an argument is insufficient to establish that a technique “wherein a half voltage of the head is more than two times greater than a half voltage of a head having a substantially similar structure but having only one barrier layer,” as claimed by applicant, is inherent by the disclosure of Figure 10 in Freitag.

Thus, because Freitag fails to disclose or inherently contain each and every limitation required by claims 7 and 16, and because the rejection fails to provide a rational basis for inclusion of inherent features in the rejection, the rejection of claims 7 and 16 is improper. Accordingly, a notice of allowance of claims 7 and 16 is respectfully requested.

With respect to claims 9 and 17, the Examiner has relied on Figure 10 from Freitag in an attempt to make a prior art showing of applicant’s claimed technique “wherein the head has a thickness of less than about 300Å.”

Figure 10 in Freitag clearly shows a head that is substantially thicker than 300Å (317Å – see Fig. 10 in Freitag). Accordingly, a notice of allowance of claims 9 and 17 is respectfully requested.

With respect to claims 19 and 20, applicant has amended such claims to require that the head has a thickness of less than about 300Å. Thus, claims 19 and 20 are deemed allowable for the same reasons set forth with respect to claims 9 and 17. Accordingly, a notice of allowance of claims 19 and 20 is respectfully requested.

Should the Examiner wish to discuss this matter further, the Examiner is invited to call the undersigned at (408) 971-2573. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. HSJ920030278US1).

Respectfully submitted,

By: /Dominic M. Kotab/  
Dominic M. Kotab  
Reg. No. 42,762

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Zilka-Kotab, PC  
P.O. Box 721120  
San Jose, California 95172-1120  
Telephone: (408) 971-2573  
Facsimile: (408) 971-4660